

REMARKS

Claims 1, 3, 7, 9 11, 37, 38 and 59 are amended. The amendments to claims 3, 7, 9, and 38 are to improve clarity. The amendment to claim 59 is supported by at least claim 37 as originally filed. The amendments to claims 1, 11 and 37 are supported by at least page 12, lines 14-20; and page 20, lines 3-5 and 15-16 of the specification. No new matter is added. Accordingly, claims 1-59 remain pending. Applicants respectfully request reconsideration and allowance of all pending claims.

Interview Summary

On August 30, 2004 and interview was held by the undersigned and Examiners Chencinski and Sough. The meanings of the terms "participants" and "users" were discussed with regard to the cited references. No agreement was reached.

Rejections Under 35 U.S.C. §112

Claims 36 and 59 are rejected under 35 U.S.C. §112, second paragraph for indefiniteness. Applicants respectfully traverse. As disclosed in the application at page 20, lines 11-14, a financial transaction manager may be implemented as a plurality of executable functions in software. Therefore, claim 36 is definite to one of ordinary skill in the art. Claim 59 is definite on a similar basis.

Rejections Under 35 U.S.C. §102

Claims 1, 2, 8, 10-19, 25, 28, 36, 37, 39, 40, 43, 49 and 52 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,963,925 (herein after Kolling). In view of the amendments to independent claims 1, 11, and 37,

1 Applicants respectfully assert that claims 1, 2, 8, 10-19, 25, 28, 36, 37, 39, 40, 43,
2 49 and 52 are patentable over Kolling.

3 Claim 1

4 Claim 1 as amended recites in part “and wherein the recipient can be either
5 a user or a non-user of a secure email system, wherein no non-user has registered
6 for a service of the secure email system” (emphasis added).

7 In contrast, Kolling discloses in Fig. 8, block 708 “consumer requests
8 electronic statement subscription for a biller”. It appears that Kolling’s system
9 requires consumers to, in effect, register for a service. Therefore, Applicants
10 respectfully assert that Kolling does not teach or suggest “wherein no non-user has
11 registered for a service of the secure email system” as recited in claim 1.
12 Consequently, Kolling does not teach and every element of claim 1, and
13 consequently, does not anticipate claim 1.

14 Claims 2, 8 and 10 depend from claim 1 and therefore are not anticipated
15 by Kolling for at least the same reasons that claim 1 is anticipated.

16 Claim 11

17 Claim 11 is amended to correct a clerical error; namely to recite “email
18 server” instead of “data server”. Further, Claim 11 is amended to recite, “wherein
19 no non-participants have registered for a service of an email system supported by
20 the email server”.

21 The office action cites Kolling col. 33, line 43 to col. 44, line 33 (essentially
22 11 columns of the reference) as disclosing an email server having a storage
23 medium and financial transaction manager. Applicants have not been able to
24 determine which component(s) in this very large amount of text is to correspond to
25 an email server. In contrast, Kolling does disclose at col. 33, lines 24-29 that “the

1 ESP system is capable of using any file transfer mechanism (and any mail
2 system)", there is no teaching or suggestion that the disclosed ESP system uses an
3 email server that includes a financial transaction manager.

4 Further, similar to argument for claim 1, Kolling discloses in Fig. 8,
5 block 708 "consumer requests electronic statement subscription for a biller". It
6 appears that Kolling's system requires consumers to, in effect, register for a
7 service. Therefore, Applicants respectfully assert that Kolling does not teach or
8 suggest "wherein no non-participant has registered for a service of the secure
9 email system" as recited in claim 11. Consequently, Kolling does not teach and
10 every element of claim 11, and consequently, does not anticipate claim 11.

11 Claims 25, 28, and 36 are dependent from claim 11 and therefore are
12 distinguished from Kolling for at least the same reasons that claim 11 is
13 distinguished.

14 Claim 37

15 Claim 37 recites features similar (although not identical) to claim 11 (i.e.,
16 "users" and "non-users" rather than "participants" and "non-participants" as in
17 claim 11). Applicants respectfully assert that claim 37 is distinguished from
18 Kolling on a similar basis as claim 11.

19 Claims 39, 40, 43, 49 and 52 depend from claim 37 and therefore are
20 distinguished from Kolling for at least the same reasons that claim 37 is
21 distinguished.

22 Rejections Under 35 U.S.C. §103

23 Claims 3, 4-6, and 9 stand rejected under 35 U.S.C. §103(a) as unpatentable
24 over Kolling in view of Blossman. Applicants respectfully traverse.
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1 As discussed above, Applicants believe that amended claim 1 is patentable
2 over Kolling. As will be described below, Blossman is cited as disclosing the
3 feature, “wherein the email message includes an address of where the bill data can
4 be confidentially viewed if the recipient is not a participant in a secure email
5 network”. This feature does not overcome the shortcomings of Kolling with
6 regard to non-users as described above for claim 1. Thus, the combination of
7 Kolling and Blossman does not teach every element of claim 1 and, therefore does
8 not make out a *prima facie* case of obviousness.

9 As claims 3, 4-6 and 9 depend from claim 1, Applicants respectfully assert
10 that these claims are patentable over the cited references for at least the same reasons
11 that claim 1 is patentable.

12 Further, with regard to claim 3, the office action acknowledges that Kolling
13 does not disclose the feature, “wherein the email message includes an address of
14 where the bill data can be confidentially viewed if the recipient is not a participant
15 in a secure email network”.

16 However, the office action then cites Blossman (col. 2, lines 40-45) as
17 disclosing this feature. Applicants respectfully assert that the cited disclosure does
18 not teach or suggest “wherein the email message includes an address of where the
19 bill data can be confidentially viewed if the recipient is not a participant in a
20 secure email network” as recited in amended claim 1. For convenience, the cited
21 disclosure from Blossman is reproduced below.

22 However, the full check image of the Simmons patent
23 is not described as a pictorial image of the actual paper
24 check and is illustrated as a printed line of text
25 conveying the check number, date, amount, etc.
Additionally, the Simmons patent discloses the use of
electronic mail for the transmission of notifications
regarding potential errors.

1 Although the above reproduced disclosure from Blossman does mention the
2 use of electronic mail for notifications regarding errors, it does not disclose “an
3 address of where the bill data can be confidentially viewed ...”

4 Therefore, Applicants respectfully assert that the combination of Kolling
5 and Blossman does not teach or suggest each and every element of claim 1, and
6 consequently, does not make out a *prima facie* case of obviousness for this
7 additional reason. As claims 3, 4-6 and 9 depend from claim 1, Applicants
8 respectfully assert that these claims are patentable over the cited references for at
9 least this additional reason that claim 1 is patentable over the cited references.

10 Claims 26, 27, 38, 50, 51, and 59 stand rejected under 35 U.S.C. §103(a) as
11 unpatentable over Kolling in view of U.S. Patent 6,629,081 (hereinafter Cornelius).
12 Applicants respectfully traverse.

13 Claims 26 and 27 depend from claim 11, and claims 38, 50, 51 and 59
14 depend from claim 37. As discussed above, claims 11 and 37 are distinguished
15 from Kolling. Cornelius is cited as disclosing an electronic auction service, an
16 electronic retail service, and an email system. However, such disclosures do not
17 overcome the deficiencies of Kolling in anticipating claims 11 and 37.
18 Accordingly, the combination of Kolling and Cornelius do not teach or suggest
19 each and every element of claims 11 and 37 and, therefore, fail to make out a
20 *prima facie* case of obviousness for claims 11 and 37. As each of claims 26, 27,
21 38, 50, 51, and 59 depend from claim 11 or 37, these dependent claims are
22 patentable over the cited references for at least the reasons that claims 11 and 37
23 are patentable over the cited references.

1 Claims 29, 31, 53, and 55 stand rejected under 35 U.S.C. §103(a) as
2 unpatentable over Kolling in view of U.S. Patent 6,678,664 (hereinafter Ganesan).
3 Applicants respectfully traverse.

4 Claims 29 and 31 depend from claim 11, and claims 53 and 55 depend from
5 claim 37. As discussed above, claims 11 and 37 are distinguished from Kolling.
6 Ganesan is cited as disclosing “wherein the financial transaction manager
7 determines whether to honor the participant’s payment when the specified account
8 has insufficient assets to cover the requested payment.” Ganesan is also cited as
9 disclosing “honoring a check if adequate prior credit arrangements are made.”
10 Ganesan is also cited as disclosing “wherein the financial transaction manager
11 automatically accesses a line of credit associated with the participant to honor the
12 payment when the specified account has insufficient assets to cover the requested
13 payment.”

14 However, such disclosures do not overcome the deficiencies of Kolling in
15 anticipating claims 11 and 37. Accordingly, the combination of Kolling and
16 Ganesan do not teach or suggest each and every element of claims 11 and 37 and,
17 therefore, fail to make out a *prima facie* case of obviousness for these independent
18 claims. As each of claims 29, 31, 53, and 55 depend from claim 11 or 37, these
19 dependent claims are patentable over the cited references for at least the reasons
20 that claims 11 and 37 are patentable over the cited references.

21 Claim 32 stands rejected under 35 U.S.C. §103(a) as unpatentable over
22 Kolling in view Ganesan and further in view of Blossman. Applicants respectfully
23 traverse.

24 Claim 32 depends from claim 11. As discussed above, claim 11 is
25 patentable over the combination of Kolling and Ganesan. Blossman is cited as

1 discosing, “wherein the financial transaction manager notifies the participant of
2 the insufficient funds and that the line of credit has been accessed to honor the
3 requested payment.”

4 However, such a disclosure does not overcome the deficiencies of Kolling
5 and Ganesan in rendering claim 11 obvious. Accordingly, the combination of
6 Kolling, Ganesan and Blossman do not teach or suggest each and every element of
7 claim 11 and, therefore, fails to make out a *prima facie* case of obviousness for
8 claim 11. As claims 32 depends from claim 11 claim 32 is patentable over the
9 cited references for at least the reasons that claim 11 is patentable over the cited
10 references.

11 Claim 30 stands rejected under 35 U.S.C. §103(a) as unpatentable over
12 Kolling in view Ganesan and further in view of U.S. Patent 5,649,116 (hereinafter
13 McCoy). Applicants respectfully traverse.

14 Claim 30 depends from claim 11. As discussed above, claim 11 is
15 patentable over the combination of Kolling and Ganesan. McCoy is cited as
16 discosing, “wherein the financial transaction manager utilizes a growing model to
17 determine whether to honor the payment when the specified account has
18 insufficient assets to cover the requested payment.”

19 However, such a disclosure does not overcome the deficiencies of Kolling
20 and Ganesan in rendering claim 11 obvious. Accordingly, the combination of
21 Kolling, Ganesan and McCoy do not teach or suggest each and every element of
22 claim 11 and, therefore, fails to make out a *prima facie* case of obviousness for
23 claim 11. As claim 30 depends from claim 11, claim 30 is patentable over the
24 cited references for at least the reasons that claim 11 is patentable over the cited
25 references.

1 Claim 54 stands rejected under 35 U.S.C. §103(a) as unpatentable over
2 Kolling in view McCoy. Applicants respectfully traverse.

3 Claim 54 depends from claim 37. As discussed above, claim 37 is
4 patentable over Kolling. McCoy is cited as disclosing, “wherein the financial
5 transaction manager utilizes a growing model to determine whether to honor the
6 payment when the specified account has insufficient assets to cover the requested
7 payment.”

8 However, such a disclosure does not overcome the deficiencies of Kolling
9 in anticipating claim 37. Accordingly, the combination of Kolling and McCoy do
10 not teach or suggest each and every element of claim 37 and, therefore, fails to
11 make out a *prima facie* case of obviousness for claim 37. As claim 54 depends
12 from claim 37, claim 54 is patentable over the cited references for at least the
13 reasons that claim 37 is patentable over the cited references.

14 Claims 22, 23, 46 and 47 stand rejected under 35 U.S.C. §103(a) as
15 unpatentable over Kolling in view of U.S. Patent 6,049,784 (hereinafter Weatherly).
16 Applicants respectfully traverse.

17 Claims 22 and 23 depend from claim 11, and claims 46 and 47 depend from
18 claim 37. As discussed above, claims 11 and 37 are distinguished from Kolling.
19 Weatherly is cited as disclosing “wherein the financial transaction manager
20 selectively receives assets for deposit in an account of a participant.” Weatherly is
21 also cited as disclosing “wherein the assets are received from a brokerage at the
22 request of the participant.”

23 However, such disclosures do not overcome the deficiencies of Kolling in
24 anticipating claims 11 and 37. Accordingly, the combination of Kolling and
25 Weatherly do not teach or suggest each and every element of claims 11 and 37

1 and, therefore, fail to make out a prima facie case of obviousness for these
2 independent claims. As each of claims 22, 23, 46 and 47 depend from claim 11 or
3 37, these dependent claims are patentable over the cited references for at least the
4 reasons that claims 11 and 37 are patentable over the cited references.

5 Claim 7 stands rejected under 35 U.S.C. §103(a) as unpatentable over
6 Kolling in view Blossman and further in view of Cornelius. Applicants respectfully
7 traverse.

8 Claim 7 depends from claim 1. As discussed above, amended claim 1 is
9 patentable over the combination of Kolling and Blossman. Cornelius is cited as
10 disclosing, “identifying a domain name from the email address; and cross
11 referencing the identified domain name against a list of secure domain names to
12 determine whether the recipient belongs to a secure email network.”

13 Applicants respectfully assert that the cited portion of Cornelius does not
14 teach or suggest identifying a domain name from an email address. Rather, the
15 cited portion of Cornelius appears to be directed to the firewalls shown in
16 FIGS. 37 and 38. As can be seen in FIGS. 37 and 38, the firewalls are directed to
17 protecting web servers and not email servers.

18 Further, the cited portion of Cornelius does not mention email address;
19 instead it lists “user names and passwords, Internet IP address or domain name.”
20 There is no indication of where the domain is obtained. Moreover, the disclosure
21 of web servers in FIGS. 37 and 38 would indicate that the domain name is
22 obtained from web address and not an email address. Therefore, the listing of
23 multiple security techniques does not teach or suggest identifying a domain name
24 from an email address.

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1 However, assuming arguendo that Cornelius does disclose identifying a
2 domain name from an email address, such a disclosure does not overcome the
3 deficiencies of Kolling and Blossman in rendering claim 1 obvious. Accordingly,
4 the combination of Kolling, Blossman and Cornelius does not teach or suggest
5 each and every element of claim 1 and, therefore, fails to make out a prima facie
6 case of obviousness for claim 1. As claim 7 depends from claim 1, claim 7 is
7 patentable over the cited references for at least the reasons that claim 1 is
8 patentable over the cited references.

9 Claims 24 and 48 stand rejected under 35 U.S.C. §103(a) as unpatentable
10 over Kolling in view Weatherly and further in view of U.S. Patent 6,401,079
11 (hereinafter Kahn). Applicants respectfully traverse.

12 Claim 24 depends from claim 11, and claim 48 depends from claim 37. As
13 discussed above, claims 11 and 37 are distinguished from Kolling combined with
14 Weatherly. Kahn is cited as disclosing “wherein the assets are received from an
15 employer as compensation to the participant.”

16 However, such a disclosure does not overcome the deficiencies of Kolling
17 combined with Weatherly with regard to claims 11 and 37. Accordingly, the
18 combination of Kolling, Weatherly and Kahn does not teach or suggest each and
19 every element of claims 11 and 37 and, therefore, fails to make out a prima facie
20 case of obviousness for these independent claims. As claims 24 and 48
21 respectively depend from claims 11 and 37, these dependent claims are patentable
22 over the cited references for at least the reasons that claims 11 and 37 are
23 patentable over the cited references.

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1 Claims 20, 21, 44 and 45 stand rejected under 35 U.S.C. §103(a) as
2 unpatentable over Kolling in view of U.S. Patent 5,983,200 (hereinafter Slotznick).
3 Applicants respectfully traverse.

4 Claims 20 and 21 depend from claim 11, and claims 44 and 45 depend from
5 claim 37. As discussed above, claims 11 and 37 are distinguished from Kolling.
6 Slotznick is cited as disclosing “wherein the first participant does not have a prior
7 knowledge of the second participant’s account information, but identifies the
8 second participant from a list of network participants, wherein the second
9 participant is identified by one of a name, an alias, or an email address.”

10 However, such disclosures do not overcome the deficiencies of Kolling in
11 anticipating claims 11 and 37. Accordingly, the combination of Kolling and
12 Slotznick does not teach or suggest each and every element of claims 11 and 37
13 and, therefore, fails to make out a *prima facie* case of obviousness for these
14 independent claims. As each of claims 20, 21, 44 and 45 depend from claim 11 or
15 37, these dependent claims are patentable over the cited references for at least the
16 reasons that claims 11 and 37 are patentable over the cited references.

17 Claims 33, 41 and 46 stand rejected under 35 U.S.C. §103(a) as unpatentable
18 over Kolling in view of Kahn. Applicants respectfully traverse.

19 Claim 33 depends from claim 11, and claims 41 and 46 depend from claim
20 37. As discussed above, claims 11 and 37 are distinguished from Kolling. Kahn
21 is cited as disclosing “wherein the financial transaction manager issues an
22 instruction to have a check issued and sent to an address specified by the request,
23 upon authorization of the participant where the participants are an employer, a
24 payment service, the employer’s bank, and the employee payee who can receive a
25

1 paper check instead of an electronic payment which is authorized by the employer
2 payer.”

3 However, such disclosures do not overcome the deficiencies of Kolling in
4 anticipating claims 11 and 37. Accordingly, the combination of Kolling and Kahn
5 does not teach or suggest each and every element of claims 11 and 37 and,
6 therefore, fails to make out a *prima facie* case of obviousness for these
7 independent claims. As each of claims 33, 41 and 46 depend from claim 11 or 37,
8 these dependent claims are patentable over the cited references for at least the
9 reasons that claims 11 and 37 are patentable over the cited references.

10 Claims 34 and 57 stand rejected under 35 U.S.C. §103(a) as unpatentable
11 over Kolling in view of Kahn and further in view of “Wells Fargo Online”.
12 Applicants respectfully traverse.

13 Claim 34 depends from claim 11, and claim 57 depends from claim 37. As
14 discussed above, claims 11 and 37 are distinguished from Kolling combined with
15 Kahn. Wells Fargo Online is cited as disclosing “the inclusion of a URL where
16 the recipient can establish an account.”

17 However, such disclosures do not overcome the deficiencies of Kolling and
18 Kahn with regard to claims 11 and 37. Accordingly, the combination of Kolling,
19 Kahn and Wells Fargo Online does not teach or suggest each and every element of
20 claims 11 and 37 and, therefore, fails to make out a *prima facie* case of
21 obviousness for these independent claims. As claims 34 and 57 respectively
22 depend from claim 11 or 37, these dependent claims are patentable over the cited
23 references for at least the reasons that claims 11 and 37 are patentable over the
24 cited references.

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Claims 35, 42 and 58 stand rejected under 35 U.S.C. §103(a) as unpatentable over Kolling in view of Kahn and further in view of U.S. Patent No. 6,442,529 (hereinafter Krishan). Applicants respectfully traverse.

Claim 35 depends from claim 11, and claims 42 and 58 depend from claim 37. As discussed above, claims 11 and 37 are patentable over Kolling combined with Kahn. Krishan is cited as disclosing “offering a free service product as an incentive for a prospect to try a service.”

However, such a disclosure does not overcome the deficiencies of Kolling combined with Kahn in with regard claims 11 and 37. Accordingly, the combination of Kolling, Kahn and Krishan does not teach or suggest each and every element of claims 11 and 37 and, therefore, fails to make out a *prima facie* case of obviousness for these independent claims. As each of claims 35, 42 and 58 depend from claim 11 or 37, these dependent claims are patentable over the cited references for at least the reasons that claims 11 and 37 are patentable over the cited references.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants believe all pending claims are allowable. Accordingly, a Notice of Allowability is respectfully requested.

Respectfully Submitted,

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By:

Lawrence E. Lycke
Reg. No. 38,540
(206) 315-4001 x103